

REMARKS

Formal Matters

A substitute specification, revised sequence listing and formal drawings are provided in order to correct various errors of form. Responsive to the Examiner's remark concerning the priority information, the paragraph at page 1, line 12 has been appropriately revised.

In amended Figures 1A-1E, Figures 2A-2B, Figures 3A-3D, Figure 4, Figure 5, Figures 6A-6F, Figure 7A-7B, Figures 8A-8D, Figure 9, Figure 10A-10D and Figure 11A-B, extraneous text was removed from the Figures.

Claims 29-54 remain in this application. No claim has been canceled. Claims 29, 39 and 49 are amended. No new matter is added by the amendments.

Support for the amendments to claims 29, 39, 49 is found at least at page 49, lines 33-36.

In view of the Examiner's earlier 6-way restriction requirement in parent application USSN 09/292,505, now U.S.P. 6,348,575, applicant retains the right to present previously withdrawn and cancelled claims in a divisional application.

The Rejection under 35 U.S.C. § 101

Claims 29-34, 37, 39-44, 47, 49-50 and 53 are rejected under 35 U.S.C. § 101 allegedly for being directed to non-statutory subject matter.

In response, Applicants amendment renders the rejection moot.

The Rejection under 35 U.S.C. § 102(e)

Claims 29-35, 37-45, 47-51, and 53-54 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,309,879. Specifically, the Examiner has alleged that the above claims are drawn to antibodies which bind to polypeptides that are at least 91%, 92%, 93%, 95% or 100% identical to SEQ ID NO:2. The Examiner further alleges that the '879 patent not only teaches a polypeptide sequence that is 99.6% identical to SEQ ID NO:2, but also antibodies binding to such polypeptide sequence.

In response, Applicants respectfully submit that the 6,309,879 patent was the losing party to Applicants' related application USSN 09/060,939, having the same inventors and filing date as the parent application (USSN 09/292,505, U.S.P. 6,348,575) of the pending application. The U.S.P.T.O. has already determined in a prior action that Applicants are the actual inventors of the subject matter claimed in the '879 patent. A copy of the final decision from Interference 105,081 awarding all of claims 1-13 of '879 patent to Applicant's 09/060,939 application appears in the Appendix. ✓

Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 29-35, 37-45, 47-51, and 53-54 under 35 U.S.C. § 102(e)

The Rejection Under 35 U.S.C. § 103(a) (cited references)

Claims 36, 46, and 52 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over the '879 patent as applied to claims 29-35, 37-45, 47-51, and 53-54 above, and further in view of Berkower.

In response, Applicants response above under the 102 reference has eliminated the relevance of the '879 patent to the pending claims. Berkower does not teach, disclose or infer antibodies that bind SEQ ID NO:2.

Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 36, 46 and 52 under 35 U.S.C. § 103(a).

Appl. No. 09/990,046

Patent Docket P1405R1C1

Amend. dated April 15, 2005

Response to the Notice of Non-Compliant amendment mailed on: April 8, 2005

SUMMARY


Claims 29-54 are pending in the application. Claims 29, 39 and 49 have been amended without prejudice to later prosecution.

If in the opinion of the Examiner, a **telephone conference** would expedite the prosecution of the subject application, the Examiner is **strongly encouraged** to call the undersigned at the number indicated below.

This response/amendment is submitted with a transmittal letter. In the unlikely event that this document is separated from the transmittal letter or if fees are required, applicants petition the Commissioner to authorize charging our Deposit Account 07-0630 for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
GENENTECH, INC.

By: 

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Date: April 15, 2005

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Appendix

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 13

Filed by: Trial Section Merits Panel
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Filed
4 April 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DAVID A. BUMCROFT,

Junior Party
(Patent No. 6,309,879),

v.

FREDERIC DE SAUVAGE
and DAVID A. CARPENTER,

Senior Party
(Application No. 09/060,939).

FAXED

APR 4 - 2003

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Patent Interference 105,081 (NAGUMO)

Before SCHAFFER, LANE, and NAGUMO, Administrative Patent Judges.

NAGUMO, Administrative Patent Judge.

JUDGMENT

(Pursuant to 37 CFR § 1.662(a))

Introduction

1. On April 2, 2003, junior party Bumcroft filed Paper 12, in which it conceded priority as to Count 1, the sole count in this interference, and acknowledged that the communication would be treated as a request for adverse judgment.

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